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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,921	10/27/2001	Senthil Kumar	REIM-0002	2210

27964 7590 06/25/2009

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ART UNIT	PAPER NUMBER
3622	

NOTIFICATION DATE	DELIVERY MODE
06/25/2009	ELECTRONIC

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/035,921
Filing Date: October 27, 2001
Appellant(s): KUMAR ET AL.

Steven J. Hanke
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 12, 2009 appealing from the Office action mailed May 19, 2008.

(1) Real Party in Interest

- A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

- The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

- The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

- No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

- The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

- The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

- The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

• 5,774,170	Hite et al.	6-1998
• PGPUB US 2002/0054087 A1	Noll et al.	5-2002

(9) Grounds of Rejection

- The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 6, 8, 13, 15, 20, and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Hite et al. (U.S. Patent Number: 5,774,170).

Claims 1, 8, and 15: Hite discloses a media and advertisement player, a method of manufacturing a media and advertisement player, and a method of playing media and advertisements and reporting the playing of the media and advertisements to a remote system respectively, each comprising:

a. A media player that receives and stores media from a remote system via said computer network and plays stored media content in response to customer requests, said customer requests constrained by playback rules that select among media content to be distributed, received, and stored among a plurality of media players, wherein said media player receives and stores, according to said playback rules, at least some different content than another of said plurality of media players, wherein said media is selected from the group consisting of audio music, music videos, and skins. (Col 1, lines 6-10; Col 5, line 28 through Col 6, line

60 through Col 7, line 34; Col 7, lines 51-63; Col 9, lines 32-42; and Col 14, lines 59-65)

b. An advertisement player that receives advertisements and a corresponding advertising schedule from said remote system via said computer network that stores and plays said advertisements according to said advertising schedule, said advertising schedule being dependent upon a play of a content of said media, wherein said advertising schedule is correlated to said stored media content, said stored media content constrained by said playback rules. (Col 6, line 10 through Col 7, line 14)

c. A tracking subsystem that generates as-run logs derived from customer requests containing records of a playing of contents of said media and said advertisements and transmits said as-run logs to said remote system via said computer network, said as-run logs employed by said remote system to adjust playback rules. (Col 4, line 62 through Col 5, line 27)

Claims 6, 13, and 20: Hite discloses the media and advertisement player, the method of manufacturing a media and advertisement player, and the method of playing media and advertisements and reporting the playing of the media and advertisements to a remote system as recited in claims 1, 8 and 15 respectively, further comprising

a personal computer, said media and said advertisements being stored on a hard disk drive of said personal computer. (Col 6, line 60 through Col 7, line 14)

Claim 22: Hite discloses the media and advertisement player of claim 1, wherein said advertising schedule being dependent upon plays of selected content of said media further comprises said advertising schedule being based on a selection of content a first media but not from a selection of content of a second media. (Col 4, line 25 through Col 5, line 27)

Claim 23: Hite discloses the media and advertisement player of claim 1, wherein said advertising schedule is based on said given advertisement and its proximity to a content of said particular media being played. (Col 4, line 25 through Col 5, line 27)

Claim 24: Hite discloses the media and advertisement player of claim 1, wherein said advertising schedule is based on at least one aspect selected from the group consisting of: a geographic location of said media player and said advertisement player, an establishment type in which said media player and advertisement player are located, a demographic of establishment in which said media and said

advertisement player is located, a time of day, a date, a day of a week, a month of a year, and a season of a year. (Col 3, line 65 through Col 4, line 11; and Col 8, lines 18-39)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2-4, 7, 9-11, 14, 16-18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hite et al. (U.S. Patent Number: 5,774,170) in view of Noll et al. (PGPUB: US 2002/0054087 A1).

Claims 2, 9, and 16: Hite discloses the media and advertisement player, the method of manufacturing a media and advertisement player, and the method of playing media and advertisements and reporting the playing of the media and advertisements to a remote system as recited in claims 1, 8 and 15 respectively. While Hite does not specifically state that there is a graphical user interface that is part of the display, Hite does discloses in Col 4, lines 52-61 that some user interactions with the

display are tracked, therefore the user must be able to interact with the display in some manner. The analogous art of Noll discloses client software on the user machine that generates a graphical user interface (Paragraph [0007]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a graphical user interface as the mechanism for initiating the user interactions disclosed by Hite. The rational for using a graphical user interface it that it is one of a limited number of predictable methods for providing the organized, consistent and efficient display of interactive data to a user.

Claims 3, 10, and 17: Hite and Noll disclose the media and advertisement player, the method of manufacturing a media and advertisement player, and the method of playing media and advertisements and reporting the playing of the media and advertisements to a remote system as recited in claims 2, 9 and 16 respectively, wherein said graphical user interface has a skin that is received from said remote system via said computer network. (Noll: Paragraphs [0007]; and [0042])

Claims 4, 11, and 18: Hite and Noll disclose the media and advertisement player, the method of manufacturing a media and

advertisement player, and the method of playing media and advertisements and reporting the playing of the media and advertisements to a remote system as recited in claims 2, 9 and 16 respectively, wherein said display is touch-sensitive. (Noll: Paragraph [0050])

Claims 7, 14, and 21: Hite discloses the media and advertisement player, the method of manufacturing a media and advertisement player, and the method of playing media and advertisements and reporting the playing of the media and advertisements to a remote system as recited in claims 1, 8 and 15 respectively. While Hite discloses that the data is transmitted to the display site via electrical means, Hite does not specifically state that the transmission occurs over the Internet. However, the analogous art of Noll discloses the transmission of commercials and other broadband data via the Internet (Noll: Paragraph [0007]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the inventions was made to use the internet as a transmission medium. The rational for using the Internet is that the Internet is one of a limited number of predicable mediums with which electronic data can be conveyed to a user.

(10) Response to Argument

- Rejection under 35 U.S.C. 102(a) over Hite
    - **Rejection of Claims 1, 8, and 15**

      The applicant argues that Hite does not disclose the following limitations:

      a. Receiving and storing media from a remote system via a computer network. However, Hite discloses in Col 6, line 60 through Col 7, line 14 that an individually addressable digital recording device (RD) with a unique address is installed at the display site in a display device which includes a VCR, and that one or more commercial identifier codes (CID) are transmitted to and recorded by an in-home storage. Then Commercials are subsequently transmitted to the in-home storage device. These commercials have codes attached indicating the conditions and rules required to display the commercial. The commercial codes in each commercial is compared to the commercial identifier codes (CIDs) previously recorded by the RD to determine whether or not to insert the commercial. Hite further discloses in Col 7, lines 35-50 that a broadcast is then transmitted with codes in the break. Thus Hite has disclosed transmitting and storing commercials in the recording device (RD) which is

installed in a VCR. Hite has also disclosed transmitting a broadcast to a VCR. The Merriam-Webster's dictionary defines a VCR as a device that uses videocassettes for recording and playing back videotapes. Thus the disclosed sections of Hite inherently include storing the transmitted broadcast on the VCR. Further support of both receiving and storing both commercials and media can be found in the Hite reference in Fig. 5 and Col 13, line 58 through Col 14, line 58 which discloses the configuration of the claimed display site. Col 13, lines 59-65 that Signals are displayed to the Display Site electrical and/or optical connection and/or radio via antenna and/or via satellite via satellite antenna to a receiver located in the display device. Optionally, physical media could be used within an Optional Playback Device located in the display device which connects via a radio frequency connection over channels 3 or 4 to the antenna terminals or cable input of the receiver. Thus Hite has disclosed the ability to operated the disclosed system utilizing media stored on a playback device such as a VCR. and the ability to transmit a broadcast to a VCR. Hence, it is clear that Hite disclosed storing and receiving both media and commercials at the local device. However, such a specific form of storage is not required by the current claim language. There

is no indication that the received media and/or commercial must be placed in a long term storage device. As such, Hite discloses in Col 13, line 66 through Col 14, line14, that the receiver in the display device preprocesses the signals it receives by electrical and/or optical connections to a frequency selector and detector, which conveys the selected and demodulated baseband signals to a data decoder which extracts data require by the invention. The data decoder extracts data required by the invention and conveys it to the Commercial processor. Col 14, lines 33-58 discloses that Digital signals selected from a digital data stream by a digital demultiplexer under control of the commercial processor are conveyed to a digital to analog converter which converts the signals into a form suitable for further processing and display. Additionally, the signals from the digital descrambler may be conveyed to the Optional Storage device. Thus the preprocessing, descrambling, decoding, demulitplexing and digital to analog conversion performed by the display device must require some form of temporary storage in order to perform the claimed operations. Finally, Hite discloses in Col 13, lines 47-57 that CID codes in Programming and which come imbedded commercials must be coded as to be

indistinguishable by ordinary means unless the receiving site is authorized to participate because a recording device could be constructed to "zap" commercials so that a VCR would be made not to record them. Arguably, this form of storage of the media would have occurred after the commercials were inserted. However, the claim as currently written only requires the receipt and storage of the media. Therefore, the Hite reference satisfies the limitations of the claims regarding a media player that receives and stores media from a remote system in more than one manner.

b. Playing the media in response to a customer request. However, as discussed above the display device can be a VCR. The examiner is unaware of any VCR that does not require a request by the customer in which initiate the playback of a recorded program. As such, the disclosure of a VCR inherently requires a customer request in order to play the media. Furthermore, Hite discloses in Col 7, lines 52-63 that the media received by the customer could be media from a Video on Demand system in which a customer requests the media be delivered to the display device. Thus a customer request is required in order to transmit, store, and play the requested media. Whether using the VOD system, or a Television

broadcast which allows the user to request a single channel from a number of channels as disclosed in Col 8, lines 7-11, the transmission, storage, and playing of the media is in response to a customer request. Hite also disclose that a customer may not be authorized to receive some types of media that is broadcast in Col 14, lines 4-8 and that only authorized media is descrambled in Col 14, lines 41, thus there are playback rules which constrain the playing of the media.

c. Playback rules constraining the receipt and storage of the media However, playback rules is a very broad term indicating that a rule of some kind must occur in order for the media to be played. When considering the VCR example, the play back rules might be if the media is stopped the user must hit play on the VCR itself, or initiate the playing using an input device. When considering some of the other disclosures, Hite discloses using the VOD system which requires a user to select a video to view in Col 7, lines 52-63, or a Television broadcast which allows the user to request a single channel from a number of channels as disclosed in Col 8, lines 7-11, the transmission, storage, and playing of the media is in response to a customer request. Thus, one type of rule may be, that a customer must

select a media in a VOD system in order to have it play. Another type of rule for the television broadcast is that the user must select the proper channel in order for the media to play. Hite also discloses more complex rules. Hite discloses that a customer may not be authorized to receive some types of media that is broadcast in Col 14, lines 4-8 and that only authorized media is descrambled in Col 14, lines 41, thus there are playback rules which constrain the playing of the media. One such rule is if a user selects a channel of a television broadcast check to see if the user is authorized before playing the media. Finally, since the media themselves have codes embedded, which are based upon as disclosed in Col 7, lines 35-50, it is from the disclosure of Hite in Col 8, lines 18-43 that the matching of a CID enabled commercial with a CID encoded program is performed according to a set of rules such as when the user specifically identifies themselves as individual X then playback the media and insert appropriate commercials for individual X in appropriate spots, when the user specifically identifies themselves as Individual Y then playback the media and insert appropriate commercials for Individual Y in appropriate spots. In this example, the playback rule is based on the requirement that a viewer identifies himself or herself

either directly or indirectly as specifically recited in Col 8, line40-44. Therefore, it is clear that Hite discloses customer requests which are constrained by playback rules, and the limitations of the claims as currently written have been satisfied.

- **Rejection of Claims 6, 13, and 20**

  The applicant argues that Claims 6, 13, and 20 require a personal computer, said media and advertisements being stored on a hard disk drive of said computer and that such a teaching is not found in the disclosure of Hite. However, Hite specifically discloses in Col 14, lines 59-65 that the invention involves supplementary electronics built into personal computers. Since a hard drive is an storage device built into a computer, and Hite discloses the inclusion of an optional playback device in Col 13, lines 57-67, the limitations of the claims as currently written have been met.

- **Rejection of Claim 22**

  The applicant argues that Hite does not disclose the limitation "wherein said advertising schedule being dependent upon plays of selected content of said media further comprises said advertising schedule being based on a selection of content a first media but not from a selection of content of second media". Claim 1 from which Claim 22 depends only receives the

advertising schedule. There is no indication that media and advertising player has any ability to modify, adjust, or create the advertising schedule. As such, the "wherein" clause is given little if any weight. As per MPEP 2111.04, Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or claim language that does not limit a claim to a particular structure. However, Hite discloses in Col 4, line 25 through Col 5, line 27 that the advertising schedule is based on the context of the different programs selected for playback. Thus the selection of a first media would provide a different advertising schedule that the selection of a second media because of contextual difference. As such the limitations of the claims as currently written have been met.

- **Rejection of Claim 23**

  The applicant argues that Hite does not disclose "wherein said advertising schedule is based on said given advertisement and its proximity to a content of said particular media being played. The claim as currently written is provided little if any patentable weight for the same reason as presented in response to claim 22 above. However, the examiner is interpreting the term "proximity" not in regards to physical location, but rather in

regards to how closely the advertisement matches the media being played. Hite, specifically includes such proximity affecting the advertising schedule in Col 4, lines 33-44. Hite discloses a context code which matches the context of the media (downhill skiing competition) with the scheduling of an of an advertisement with a similar context (skiing equipment commercial). Thus the limitations of the claims as current written have been satisfied.

- **Rejection of Claim 24**

The applicant argues that Hite does not disclose the "wherein said advertising schedule is based on **at least one** aspect selected from the group consisting of: a geographic location of said media player and said advertisement player, an establishment type in which said media player and advertisement player are located, a demographic of establishment in which said media and said advertisement player is located, a time of day, a date, a day of a week, a month of a year, and a season of a year". The claim as currently written is provided little if any patentable weight for the same reason as presented in response to claim 22 above. However, Hite specifically discloses Col 7, lines 1-14 discloses that the advertising schedule is based upon

a date or day-part. As such, Hite discloses the limitations of the claims as currently written.

- Rejection under 35 U.S.C. 103(a) over Hite in view of Noll
  - **Rejection of Claims 2, 9, and 16**

    The applicant argues that Hite does not teach the limitations of Claim 1, 8, and 15 from which these claims depend and that Noll does not cure the deficiencies of the independent claims. However, as discussed in the arguments above, Hite discloses all of the limitations of Claims 1, 8, and 15 as currently written. Thus the examiner relies on the arguments directed towards Claims 1, 8, and 15 above.
  - **Rejection of Claims 3, 10, and 17**

    The applicant argues that the combined references of Hite and Noll do not disclose "a display that presents a graphical user interface." This limitation is not found in Claims 3, 10, and 17 directly. However, the limitation is presented in Claims 2, 9, and 16 from which they depend. None the less, Hite discloses that the media is displayed but does not specifically describe the display. Hite does disclose the display can be used in a VOD system, in which the user requests programming in Col 7, lines 52-56. Thus it is suggested the Hite discloses a graphical display

in which a user is able to interface. However, the combined reference of Noll discloses in Paragraph [0007] the generation and transmission of a graphical user interface including different "skins" to the client control channel through which a user views and selects content. Thus, the limitations of the claims as currently written have been met.

- **Rejection of Claims 4, 11, and 18**

  The applicant argues that the combination of the Hite and Noll references does not disclose "wherein said display is touch sensitive". However, Noll specifically discloses in Paragraph [0050] receiving user input via a touch screen. Thus, the limitations of the claims as currently written have been met.

- **Rejection of Claims 7, 14, and 21**

  The applicant argues that Hite does not teach the limitations of Claim 1, 8, and 15 from which these claims depend and that Noll does not cure the deficiencies of the independent claims. However, as discussed in the arguments above, Hite discloses all of the limitations of Claims 1, 8, and 15 as currently written. Thus the examiner relies on the arguments directed towards Claims 1, 8, and 15 above.

(11) Related Proceeding(s) Appendix

- No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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